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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/446,373 | 07/11/2000 | HANS-PETER CALL | 21373.003 | 2237 |

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EXAMINER

WEBER, JON P

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 10/25/2002

29

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--|-------------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/446,373 | CALL, HANS-PETER | |
| | Examiner Jon P. Weber, Ph.D. | Art Unit 1651 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 101-150 is/are pending in the application.
 4a) Of the above claim(s) 139-150 is/are withdrawn from consideration.
 5) Claim(s) ____ is/are allowed.
 6) Claim(s) 101-138 is/are rejected.
 7) Claim(s) ____ is/are objected to.
 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 11) The proposed drawing correction filed on ____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ . | 6) <input type="checkbox"/> Other: _____ |

Status of the Claims

The responses with amendments filed 26 February 2002 and 01 July 2002 have been received and entered. Claims 101-150 have now been presented for examination.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

Claims 139-150 remain FINALLY withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions Group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9, filed 13 June 2001. A complete reply to the final rejection **must** include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01. Claims 101-138 remain to be considered on the merits.

Claim Rejections - 35 USC § 101/112

Claims 101-138 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 131-138 still provide for the “use of” an enzyme component system, but, since the claims do not set forth any steps involved in the method/process, it is unclear what

method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 131-138 remain rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Accordingly, claims 131-138 have been further treated on the merits as composition claims dependent only from claim 101. Claims 131 and 135-138 are treated as compositions with functional intended uses, and claims 132-134 are treated as methods with the conditions set forth as method step limitations.

The claims are replete with indefinite language and awkward syntax. Applicant is urged to carefully modify the claims to conform to accepted legal claim language. The following rejections are representative of the indefiniteness present, but no representation is made that these rejections are comprehensive.

Claims 101-138 still recite “enzyme component system”. It remains unclear if these components are part of a single composition or are separately packaged components as in a kit.

In claim 101 (a), the list of enzymes appears to be one large Markush group, restating “or at least ...” in the middle of the claim is redundant. Normally Markush claims are written A, B and C.

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Claim 101(b) recites “consisting C₆ to C₂₆” which should be “consisting **of** C₆ to C₂₆”; the parentheses should not be present.

Claims 102-120 and 125-130 recite “comprising that” which is awkward syntax and lacks antecedent basis (claim 101 recites “consisting of”); “wherein the” or “wherein” is suggested in many instances.

Claim 102 appears to be incomplete. The system component is not identified and there is no closing period.

Claim 104 recites “obtained selected from the group of”; “obtained from the group selected from” is suggested.

Claim 104 recites “*from wheat seedlings or pancreas*”; “wheat seedlings and pancreas” is suggested (no italics – not Latin names).

Claim 105 recites “modified enzymes” and “part of enzymes” which is vague and indefinite because the nature and manner of the modification and parts of the enzymes is unclear. Further these limitations lack antecedent basis.

Claim 107 and 127 recite “enzyme constituents, prosthetic groups or mimicking substances” which are not only vague and indefinite but lack antecedent basis. It is not clear how any of these could be considered enzymes. These claims are unfounded.

Claim 110-114 recites a list of peroxides which lack antecedent basis in that claim 101 requires that the system component 3 is peroxide **precursors** not the peroxides themselves.

Claims 111-114 are improperly dependent on claim 110.

Claim 115 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from a multiple dependent claim. See MPEP

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§ 608.01(n). Accordingly, claim 115 has been further treated on the merits as if it depended only from claims 101 and 110. Claim 115 has several instances of confusing and awkward syntax.

Regarding claim 116, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). It is suggested to use "selected from". The claim recites "The R¹" that should not be capitalized. The claim appears to have several sentences; there should only be one. The claim recites "Moreover" which is idiomatic and should not be capitalized.

Regarding claim 117, the phrase "as well as" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed Markush group. The claim recites the idiomatic "once again", has multiple sentences and "Moreover" which is idiomatic and should not be capitalized. The claim says "can form a ring" which is confusing because it is not clear if a ring is required or not.

Claim 119 recites "as those" which should be "consisting of those".

Regarding claim 120, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claims 121-130 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from a multiple dependent claim. See MPEP § 608.01(n). Accordingly, claims 121-130 have been further treated on the merits as if they depended only from claim 101.

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Claims 121-126 and 128-130 lack antecedent basis for additional components. Claim 101 recites "consisting of" four specific components. It is not possible to add additional components besides those four recited. These limitations are not further treated on the merits.

Regarding claim 131, the phrase "among others" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 132, the phrase "namely" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 133 recites "or before or after and the acid wash" which is confusing. Should there be a comma before the "and"?

Claims 133-135 recite "a Q-step" which is not understood.

Claim 133 recites "... of chelator" which lacks antecedent basis.

Regarding claim 135, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 136 recites "the swelling step" which lacks antecedent basis.

Claim 137 recites "additionally added" which lacks antecedent basis.

Claim 138 is confusing. It is not clear what is required by the claim.

Applicant's arguments filed 26 February 2002 have been fully considered but they are not persuasive. The rejection under 35 U.S.C. 112, second paragraph and 101 are adhered to for the reasons of record and the additional reasons above.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 101-138 are now rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims now require that component 3 is an “oxidant precursor”. There does not appear to be any evidence that an “oxidant precursor” was contemplated or suggested in the disclosure. The disclosure only presents oxidants themselves. This is a **new matter** rejection. A response to this rejection requires cancellation of the new matter or other appropriate action.

Claim Rejections - 35 USC § 102/103

The rejections under these statutes are withdrawn in view of the claims language "consisting of" in claim 101. The previously relied upon art, Bailllely et al. (WO 96/06148) and Gordon et al. (US 5,719,112), are detergent compositions. The closed language of the instant claims does not allow for the addition of additional detergent components. The previously relied upon art, Kaaret (US 5,478,356), provides for addition of proteases in addition to lipases. The closed language of the instant claims does not allow for the addition of additional enzymes, not of the same classes of hydrolase enzymes claimed (proteases are EC 3.4).

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

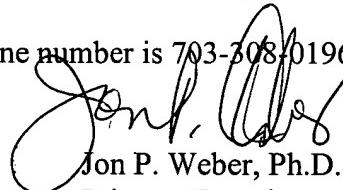
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon P. Weber, Ph.D. whose telephone number is 703-308-4015. The examiner can normally be reached on daily, off 1st Fri, 9/5/4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 703-308-4743. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196



Jon P. Weber, Ph.D.
Primary Examiner
Art Unit 1651

JPW
October 22, 2002